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01 JUN 2009

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In re Application of: KHAN, Nazir et al.

Application No.: 10/584,121

PCT No.: PCT/GB2005/000121

Int. Filing Date: 14 January 2005

Priority Date: 14 January 2004

Atty Docket No.: GJE-7660

For: LASER IMAGING

: DECISION
: ON
: PETITION
: UNDER
: 37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition to File Application Without Signature of Joint Inventor" under 37 CFR 1.47(a) filed 04 February 2008. The Deposit Account No. 19-0065 will be charged the required \$200 petition fee.

BACKGROUND

On 14 January 2005, applicants filed international application PCT/GB2005/000121. The international application claimed priority date of 14 January 2004 and designated the United States. On 28 July 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the international filing date, i.e., 14 July 2006.

On 23 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, *inter alia*, payment of the basic national fee.

On 04 November 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 04 February 2009, applicant filed a response to the Notification of Missing Requirements that included payment extension of time for 1 month, payment of the required surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered

herein. The petition seeks acceptance of the application without the signature of inventor Nazir KHAN, whom applicant asserts has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventor on behalf of himself and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicant here has authorized a charge to Deposit Account No. 19-0065 for the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicant has filed a declaration that contains an unsigned signature block for the non-signing inventor and is executed by the other inventor of record. This declaration can be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, “[a] copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, the evidence submitted to show that inventor Nazir KHAN has refused to sign is insufficient. The applicant has presented a letter by RE Perry dated 16 June 2006 which states a copy of application was included. However, this letter fails to specifically indicate the application number. Further, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers were sent to Nazir KHAN and when such papers were sent and that Nazir KHAN has subsequently refused to execute the

application. The declaration of Mr. Andrew Whyte constitutes secondhand knowledge, in that the mailing of the application was conducted by RE Perry.

CONCLUSION

Applicant's petition to permit the applicants to file the above-captioned application on behalf of the non-signing inventor, Nazir KHAN, is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.



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